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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,052

02/02/2006

Jean-Luc Rhenter

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4872

2746

7590

06/30/2008

WILLIAM H. EILBERG

THREE BALA PLAZA

SUITE 501 WEST

BALA CYNWYD, PA 19004

EXAMINER

KAVANAUGH, JOHN T

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

06/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,052	Applicant(s) RHENTER, JEAN-LUC	
	Examiner /Ted Kavanaugh/	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to because the plane upon which a sectional view is taken should be indicated on the general view by a broken line, the ends of which should be designated by numerals corresponding to the figure number of the sectional view and have arrows applied to indicate the direction in which the view is taken, see CFR 1.84(h)(3). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

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2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11-14,16,19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5014706 (Phillipp).

Phillipp teaches an insole having structure as claimed including two different stiffnesses including bearing regions (roman numerals I and II as shown in different embodiments) which have a lower relative stiffness or hardness under the bearing regions as defined in claim 12 and a higher stiffness or hardness (as shown by roman numeral III). Regarding claim 14, the main surface bearing regions (I – 32,33,34,35) all have the same relative stiffness or hardness (see col. 3, lines 48-55). With respect to the "peripheral contour conformed to extend beyond the plantar surface of the foot and to fit inside the interior contour of the footwear", this would be dependent on the size of the foot and the size of the shoe and inasmuch as these are not claimed in combination the requirement would be satisfied by picking an insole with a larger peripheral contour greater than the foot and the interior contour of the footwear. Regarding claim 19, see figure 6 which shows a greater thickness in the central region and lesser thickness in the end regions.

4. Claims 11,13,14,16,19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2003/0061738 (Grohninger).

Grohninger teaches an insole having structure as claimed including two different stiffnesses including bearing regions (container 6 extending under bearing regions 2,3,4,5; see figure 1a and paragraph #50) which have a lower relative stiffness or hardness and another region (1) having a higher stiffness or hardness. With respect to the “peripheral contour conformed to extend beyond the plantar surface of the foot and to fit inside the interior contour of the footwear”, see figure 1b which shows the sides of the insole curved upward and therefore would have a larger peripheral contour greater than the foot and the interior contour of the footwear. Regarding claim 19, see figure 1b which shows a greater thickness in the central region and lesser thickness at the tapered end regions (the sides).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15,17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillip '706.

Phillip teaches a plantar insole as claimed (see the rejection above) except for the specific stiffness and thickness as claimed. The selection of a suitable stiffness or hardness for the insole, would appear to constitute no more than an obvious design choice inasmuch as a number of different hardness would appear

to be suitable depending on the individual wearer (size of wearer), the activity for be used for (running, or walking or the particular sport being claimed) and the terrain be used on. Therefore, it is the examiner's conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum stiffness or hardness for the insole and thereby arrive at the range claimed by the applicant. Regarding the thickness of the insole, see col. 7, lines 3-9 of Phillip wherein it teaches the insole thickness to be in the range as claimed but not the specific thicknesses as claimed. The selection of a suitable thickness for the insole, would appear to constitute no more than an obvious design choice inasmuch as a number of different thickness would appear to be suitable depending on the individual wearer (size of wearer), the activity for be used for (running, or walking or the particular sport being claimed) and the terrain be used on. Therefore, it is the examiner's conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum thickness for the insole and thereby arrive at the specific thicknesses as claimed by the applicant.

7. Claims 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 11 above, and further in view of Official Notice.

The examiner takes official notice that it is old and conventional in the art to provide insoles with an antibacterial upper film and a comfort fabric. Therefore, it would be obvious to provide the insole as taught above with an antibacterial upper film and comfort fabric to provide additional comfort to the wearer's foot.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

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Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In United States OR CANADA) or 571-272-1000.

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
June 28, 2008